

REMARKS

Claims 1, 21, 36, 58, 78, 86, 93, 95, 118, 119, 134, 137, 142 and 145-163 were pending of which claims 21, 36, 58, 78, 86, 93, 95, 118, 119, 134, 137, 142 and 145 were withdrawn. In an Office Action dated November 13, 2009, claims 1 and 146-163 were rejected. Applicants thank Examiner for examination of the claims pending in this application and address Examiner's comments below.

Applicants have discovered that the previously pending claims were misnumbered and included two claims numbered 148. The claims have been renumbered to correct the error with the changes marked up.

Applicants are canceling correctly numbered claims 147 and 154, and amending correctly numbered claims 1, 146, 148-153 and 155-164 in this Amendment and Response. Following entry of the amendment and correction of claim numbering, claims 1, 146, 148-153 and 155-164 will be pending of which 21, 36, 58, 78, 86, 93, 95, 118, 119, 134, 137, 142 and 145 are withdrawn.

Support for Amendments to the Claims

Claim 1 has been amended to recite the limitation, "wherein said substance of abuse is alcohol." Support for this limitation can be found throughout the Instant Application and specifically in the Examples ([0300]-[0422]). Claim 1 has been further amended for clarity. The limitation "whereby said administering of said adenosine receptor antagonist and said dopamine receptor antagonist enhances the potency of said adenosine receptor antagonist" is found in the originally filed claim limitation "wherein the effective amount of the adenosine receptor antagonist is lower than the effective amount of an adenosine receptor antagonist

administered without said dopamine receptor antagonist” as well as throughout the Instant Application including at [0074].

Claim 146 has also been amended for clarity. Support for the limitation “whereby said administering of said adenosine receptor antagonist and said dopamine receptor antagonist enhances the potency of said dopamine receptor antagonist” is found in the originally filed limitation, “wherein the effective amount of the dopamine receptor antagonist is lower than the effective amount of a dopamine receptor antagonist administered without said adenosine receptor antagonist” as well as throughout the Instant Application including at [0074].

Claims 149-164 have been amended to conform the claim with the correction in claim numbering.

Response to Rejection Under 35 USC §103(a)

The Examiner rejected claims 1, 146-163 under 35 USC §103(a) as allegedly being unpatentable over Diamond et al. (U.S. Patent No. 5,069,895) (“Diamond”) in view of Yao et al. (*Cell*. 109:733-743, 2002) (“Yao”) and Beasley et al. (U.S. Patent No. 6,159,963) (“Beasley”). This rejection is respectfully traversed.

The Applicants note that Yao was published June 14, 2002 as shown on the reprint of the reference. The Instant Application claims the benefit of prior-filed U.S. provisional application 60/368,417 filed on March 27, 2002, before the publication of Yao. Therefore, Yao is not properly prior art to the Instant Application. Applicants respectfully request the Examiner to withdraw Yao as a reference.

A proper rejection under 35 U.S.C. § 103 requires, *inter alia*:

1. a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
2. a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;
3. a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
4. whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

72 Fed. Reg. 57,529 (Oct. 10, 2007)

Claim 1, as amended, recites:

A method of mitigating one or more symptoms associated with chronic consumption of a substance of abuse by a mammal, wherein said substance of abuse is alcohol, said method comprising:

administering to said mammal an effective amount of an adenosine receptor antagonist and an effective amount of a dopamine receptor antagonist;

wherein said administering of said adenosine receptor antagonist and said dopamine receptor antagonist enhances the potency of said adenosine receptor antagonist.

The cited references alone or in combination do not disclose all of the limitations of claim 1. The Examiner cites Yao as disclosing treating excessive drinking with drugs that target the synergy of adenosine and dopamine receptors. As explained previously, Yao is not prior art to the Instant Application. Diamond and Beasley do not disclose “wherein said

administering of said adenosine receptor antagonist and said dopamine receptor antagonist enhances the potency of said adenosine receptor antagonist” nor would one of ordinary skill in the art have recognized that feature from the combination of Diamond and Beasley. In fact, the feature, “wherein said administering of said adenosine receptor antagonist and said dopamine receptor antagonist enhances the potency of said adenosine receptor antagonist,” is intended to capture the inventors discovery of synergistic effects of the combined action of a dopamine receptor antagonist with an adenosine receptor antagonist, a result that is not taught, suggested, nor indeed expected from the combination of Diamond and Beasley. Rather, the claimed invention reflects unpredictability in this art as demonstrated by the fact that when combined as claimed, these receptor antagonists function more effectively than they do when administered separately. Therefore, the combination of Diamond and Beasley cannot render claim 1 obvious. As claims 146-153 and 155-164 depend from claim 1, they are similarly patentable over Diamond and Beasley.

Conclusion

Reconsideration of the claims is respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant’s representative at (415) 875-2406.

Respectfully Submitted,
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